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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,898	03/15/2002	Vijay Kataria	DP-304987	5374

7590 04/26/2004  
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EXAMINER

VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
2835	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/099,898	KATARIA, VIJAY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anatoly Vortman	2835	<i>pv</i>

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-17 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1103</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Amendment*

1. The submission of the Applicant's amendment filed on 03/12/04 is acknowledged. At this point claims 8 and 9 have been cancelled. No claims have been amended. Thus, claims 1-7 and 10-17 are pending in the instant application.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7 and 10, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,985,697 to Chaney et al., (Chaney).

Regarding claims 1, 2, and 7, Chaney disclosed (Fig. 3) an electronics assembly comprising: a heat generating electrical component (310); a heat sink / metal case (320) positioned to define a gap between said heat generating component (310) and said heat sink (320); at least one cured thermal adhesive member (322) filling said gap. Regarding the limitations: "at least one pre-cured thermal adhesive member" and "at least one post-cured thermal adhesive member", please note that said limitations are directed to a method steps of

production of the device and are not the limitations pertained to the final product. It is not important for the final structure when (timewise) said thermal adhesive members have been cured, since in the final product only the cured thermal adhesive is present in the gap. The method of forming the device is not germane to the issue of patentability of the device itself. Even though the claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

Alternatively, using the same approach, claim 1 is rejected as anticipated by Applicant's Admitted Prior Art (see p. 2 of the specification of the instant application, lines 1+).

Regarding claims 3-5, and 10 the claims are the claims recite various method steps of the production of the device (i.e. forming at least one pre-cured thermal adhesive member having dots of equal height and affixing it to the components of the device) and to the limitations of the device while in production (i.e. not to the final product).

Even though the claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 6, Chaney disclosed a substrate (302) and a clamping mechanism (324, 328, 330).

***Allowable Subject Matter***

4. Claims 11-17 are allowed (see previous Office Action).

***Response to Arguments***

5. Applicant's arguments presented in an amendment filed on 03/12/04 have been fully considered but they are not persuasive.

The main thrust of the Applicant's arguments is believed to be represented by the following statements: "Chaney et al., ...does not teach or suggest a pre-cured adhesive member that provides gap control, as opposed to the procured material that bonds the elements" and "Claim 1 is directed to Applicant's electronics assembly that includes, in addition to a post-cured thermal adhesive member, at least one pre-cured adhesive member within the gap between the heat generating component and the heat sink. The cited art shows only a post-cured adhesive member. Nothing in the cited art shows a pre-cured adhesive member. Therefore, the art does not show Applicant's invention as set forth in claim 1".

The Examiner believes that Applicant did not address the main point of the outstanding rejection, i.e. that said pre-cured adhesive is utilized only during manufacturing stages of the device and is not present in the end product of the instant invention. Furthermore, the Applicant

went on stating that “Nothing in the art contemplates the presence of pre-cured member. Thus the art cannot teach or suggest Applicant’s invention”. Again, the Examiner would like to direct the Applicant’s attention to the fact that the end product of the instant invention does not contain any pre-cured adhesives, since all of the adhesives that were pre-cured during manufacturing stages have become post-cured in the end product. Thus, all of the limitations directed to the pre-cured adhesives have been construed by the Examiner as related to the method steps of forming the device and therefore have not been given patentable weight, since the method of forming the device is not germane to the issue of patentability of the device itself. Even though the claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Furthermore, the Applicant went on stating that “Chaney et al.,...does not teach or suggest a pre-cured adhesive member that provides gap control”. The Examiner would like to direct the Applicant’s attention to the fact that no limitations directed to the “gap control” are present in the disputed claims. Please note, that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 571-272-2800, ext 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AV

A handwritten signature in black ink, appearing to read 'A. Vortman', followed by a horizontal line.

Anatoly Vortman  
Primary Examiner  
Art Unit 2835